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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,908	01/16/2004	Felix Capanni	60,500-114	7057

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EXAMINER

GEHMAN, BRYON P

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

10/758.908

Applicant(s)

CAPANNI ET AL.

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 6/3/04.
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the existence of a second plate, does not reasonably provide enablement for what this comprises in the context of the claimed invention, as the detailed description fails to indicate what this mentioned plate consists of. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to provide the invention commensurate in scope with these claims. The second plate, while mentioned, is not explained in the specification in sufficient detail to provide the mentioned second plate, or if actually shown, is not described in the written description as to its disposition within the disclosed structure.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 4 and claim 4, line 3, "the inserted

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bone screws" lacks antecedent basis, as no screws per se are actually inserted in the orifices, the deletion of "the" correcting the antecedent problem.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-9, 11-15 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Happonen et al. (7,007,798). Claims 1-2, 4-9, 11-15 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mikels (5,437,368). Claims 1-2, 4-9, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakata et al. (4,955,476). Each discloses a system for keeping ready bone screws comprising a device (1; 10; 10; respectively) capable of receiving bone screws, the device having a surface (top of 4; top of 10; top of 11) with a plurality of orifices (2; 30; 12) for inserting the bone screws, the device allowing inserted bone screws to be kept countersunk in relation to the surface (see Figure 1b; see Figure 3; see Figures 2 and 3), and a removal instrument (13; 41; 109 and 110) for removing a bone screw from the device,

the removal instrument dimensioned so that it is insertable into one of the orifices to remove a bone screw (see Figure 1b; see Figure 3; see Figures 2 and 3). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). That the particular contained screw be subsequently used in a bone does not differentiate the screw devices of the prior art from that claimed.

As to claims 2, 5 and 17, each discloses each orifice dimensioned to guide the removal instrument into the orifice.

As to claim 3, see Happonen et al., column 4, lines 1-8.

As to claims 6 and 7, each discloses pocket holes with contained screws lying on the bottom of the pocket holes (the pocket holes extending as far as the engagement of the bottom of the screw head with the orifice).

As to claims 8 and 9, each discloses the orifices as through orifices and a first plate (4; 10; 11) is disclosed.

As to claim 11, Happonen et al. and Mikels as disclosed would not comprise more than slight springing properties.

As to claims 12-15 and 18-20, Happonen et al. and Mikels each disclose the delimitation walls of the orifices reduced in diameter below the surface, the reduction in

diameter being gradually decreasing continuously or in steps, the reduction in inner diameter acting as a stop for the heads of a contained screw.

As to claim 16, Nakata et al. disclose a grid arrangement (see Figure 1).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 4-9 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strong (6,830,573) in view of either one of Mikels and Nakata et al.. Strong et al. discloses a system for keeping ready bone screws comprising a device (200) for bone screws, the device having a surface with a plurality of orifices (212) for inserting the bone screws, the device allowing inserted bone screws to be kept, and a removal instrument (40) for removing a bone screw from the device. Mikels and Nakata et al. disclose a system for keeping screws comprising a device (10; 10; respectively) for screws, the device having a surface (top of 10; top plane of 11) with a plurality of orifices (30; 12) for inserting the screws, the device allowing inserted screws to be kept countersunk in relation to the surface (see Figure 3; see Figures 2 and 3), and a removal instrument (41; 109 and 110) for removing a screw from the device, the removal instrument dimensioned so that it is insertable into one of the orifices to remove a screw (see Figure 1; see Figure 13). To employ the countersunk teaching of either

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one of Mikels and Nakata et al. to modify the bone screw system of Strong et al. would have been obvious in order to better protect the screws from damage prior to use.

As to claims 2, 5 and 17, Mikels and Nakata et al. each disclose each orifice dimensioned to guide the removal instrument into the orifice.

As to claims 6 and 7, Mikels and Nakata et al. each disclose pocket holes with contained screws lying on the bottom of the pocket holes (the pocket holes extending as far as the engagement of the bottom of the screw head with the orifice).

As to claims 8 and 9, Mikels and Nakata et al. each disclose the orifices as through orifices and a first plate (10; 11) is disclosed.

As to claim 11, Strong et al. and Mikels as disclosed would not comprise more than slight springing properties.

As to claims 12-15 and 18-20, Mikels discloses the delimitation walls of the orifices reduced in diameter below the surface, the reduction in diameter being gradually decreasing continuously or in steps, the reduction in inner diameter acting as a stop for the heads of a contained screw.

As to claim 16, Nakata et al. disclose a grid arrangement (see Figure 1).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art show devices for containing screws prior to use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571)

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272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Bryon P. Gehman", with a stylized, flowing script.

Bryon P. Gehman
Primary Examiner
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BPG